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09/768,213	01/24/2001	Hideyuki Kuwano	50023-132	2306
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McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER PHAM, THIERRY L	
			ART UNIT 2624	PAPER NUMBER 5

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/768,213

Applicant(s)

KUWANO ET AL.

Examiner

Thierry L Pham

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/034999.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

Responsive to Unsigned Declaration has been received/acknowledged and entered as paper no. 3.

Pre-Amendment filed on 1/24/01 have been received and entered as paper no. 4.

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 12 recites the limitation "cover original" in page 45, lines 3-5. There is insufficient antecedent basis for this limitation in the claim.

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Lopresti et al (U.S. 5754308).

Regarding claim 1, Lopresti discloses a digital integrated apparatus (digital photocopier, col. 3, lines 50-67) capable of storing (stores via storage medium within photocopier, col. 2, lines 17-22, col. 7, lines 4-55 and col. 8, lines 5-13) storing documentary image data corresponding to some specific document input from a facsimile receiving means (digital photocopier includes facsimile function, fig. 3) as a documentary image input means, by attaching document ID (DocID software incorporated within the digital photocopier for encoding and assigning ID mark, col. 2, lines 48-67 and col. 8, lines 35-4) identifying the documentary image data in at least

Art Unit: 2624

one kind of storing means controlling attribute information containing that document ID with document management means (manages via control panel, fig. 3), and outputting specified documentary image from output means based on said document ID as required, comprising:

- (1) a document ID encoding means (DocID software incorporated within the digital photocopier for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) for generating document ID mark corresponding to said document ID when storing documentary image data corresponding to said specific document in said storing means;
- (2) a pattern synthesizing means (encrypting means for embedding ID mark onto the printed document, ref. 37, fig. 2, col. 2, lines 31-67) for synthesizing document ID mark produced by said document ID encoding means and documentary image data corresponding to said specific document; said
- (3) output means (printing means for printing document with ID mark, ref. #37, fig. 2, col. 2, lines 31-37) for outputting documentary image with document ID mark generated by said pattern synthesizing means, while storing it in said storing means, and said
- (4) document management means for automatically storing (automatically saves a digital representation of document, col. 2, lines 17-22) documentary image received by said facsimile receiving means.

Regarding claim 2, Lopresti discloses a digital integrated apparatus (digital photocopier, col. 3, lines 50-67) capable of storing documentary image data corresponding to some specific document input from at least one kind of documentary image input means (scanner, col. 4, lines 1-5) by attaching document ID identifying (assigning document with ID mark, fig. 2, col. 7, lines 35-55 and col. 8, lines 1-15) the documentary image data in at least one kind of storing means (stores via storage medium within photocopier, col. 2, lines 17-22, col. 7, lines 4-55 and col. 8, lines 5-13) controlling attribute information (i.e. document parameters, col. 8, lines 14-47) containing that document ID with document management means, and outputting specified documentary image from output means based on said document ID as required, comprising:

- (1) a document ID encoding means (DocID software for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) for generating document ID mark corresponding to said document ID

Art Unit: 2624

when storing documentary image data corresponding to said specific document in said storing means;

(2) a pattern synthesizing means (encrypting means for embedding ID mark onto the printed document, ref. 37, fig. 2, col. 2, lines 31-67) for synthesizing document ID mark produced by said document ID encoding means and documentary image data corresponding to said specific document, and

(3) said output means (printing means for printing document with ID mark, ref. #37, fig. 2, col. 2, lines 31-37) for outputting documentary image with document ID mark generated by said pattern synthesizing means, while storing it in said storing means, wherein said documentary image includes only the attribute information of said specific document.

Regarding claim 3, Lopresti further discloses a digital integrated apparatus as defined in claim 1, wherein all pages (col. 6, lines 10-25) of said specific document are output together with said documentary image with document ID mark.

Regarding claim 4, Lopresti further discloses a digital integrated apparatus capable of storing documentary image data corresponding to some specific document input from at least one kind of documentary image input means by attaching document ID identifying the documentary image data in at least one kind of storing means controlling attribute information containing that document ID with document management means, and outputting specified documentary image from output means based on said document ID as required, comprising:

(1) a document ID encoding means (DocID software for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) for generating document ID mark corresponding to said document ID when storing documentary image data corresponding to said specific document in said storing means;

(2) a pattern synthesizing means (encrypting means for embedding ID mark onto the printed document, ref. 37, fig. 2, col. 2, lines 31-67) for synthesizing document ID mark produced by said document ID encoding means and documentary image data corresponding to said specific document; and said

Art Unit: 2624

(3) output means (printing means for printing document with ID mark, ref. #37, fig. 2, col. 2, lines 31-37) for outputting documentary image with document ID mark generated by said pattern synthesizing means, wherein only said documentary image with document ID mark is output.

Regarding claim 5, Lopresti further discloses a digital integrated apparatus as defined in claim 4, wherein said documentary image input means is an image reading means (scanner, col. 4, lines 1-5).

Regarding claim 6, Lopresti further discloses a digital integrated apparatus as defined in claim 4, wherein said documentary image input means is a facsimile receiving means (fig. 4, col. 4, lines 1-13).

Regarding claim 7, Lopresti further discloses a digital integrated apparatus as defined in claim 4, wherein said documentary image input means is a facsimile transmitting means (fig. 4, col. 4, lines 1-13).

Regarding claim 8, Lopresti further discloses a digital integrated apparatus as defined in claim 3, wherein said documentary image input means is a printed image receiving means from a computer (fig. 4, col. 8, lines 1-13).

Regarding claims 9-10, Lopresti further discloses a digital integrated apparatus capable of storing documentary image data corresponding to some specific document input from at least one kind of documentary image input means by attaching document ID identifying the documentary image data in at least one kind of storing means controlling attribute information containing that document ID with document management means, and outputting specified documentary image from output means based on said document ID as required, comprising:

(1) an image reading means (scanner, col. 4, lines 1-5) as said document image input means, a document ID encoding means (DocID software for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) for generating document ID mark corresponding to said document ID when storing documentary image data corresponding to said specific document in said storing means;

- (2) a pattern synthesizing means (encrypting means for embedding ID mark onto the printed document, ref. 37, fig. 2, col. 2, lines 31-67) for synthesizing document ID mark produced by said document ID encoding means and documentary image data corresponding to said specific document, said
- (3) output means (printing means for printing document with ID mark, ref. #37, fig. 2, col. 2, lines 31-37) for outputting documentary image with document ID mark generated by said pattern synthesizing means, and said
- (4) document management means (DocID software, col. 8, lines 35-65) for instructing output from said image reading means to be input directly in the pattern synthesizing means and a documentary image corresponding to said specific document to be printed out from the output means.

Regarding claims 11-13, Lopresti further discloses a digital integrated apparatus as defined in any one of claims 2, 4, or 9, wherein said document ID encoding means outputs document ID mark and position information including a form size and layout position to the pattern synthesizing means, and wherein said pattern synthesizing means determines a position of the document ID mark based on said position information (DocID comprising layout and input parameters, col. 6, lines 60-67 and col. 8, lines 14-34).

Regarding claim 14, Lopresti further discloses a digital integrated apparatus capable of storing documentary image data corresponding to some specific document input from at least one kind of documentary image input means by attaching document ID identifying the documentary image data in at least one kind of storing means controlling attribute information containing that document ID with document management means, and outputting specified documentary image from output means based on said document ID as required, comprising:

- (1) a document ID encoding means (DocID software for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) for generating document ID mark corresponding to said document ID when storing documentary image data corresponding to said specific document in said storing means;

Art Unit: 2624

(2) a pattern synthesizing means (encrypting means for embedding ID mark onto the printed document, ref. 37, fig. 2, col. 2, lines 31-67) for synthesizing document ID mark produced by said document ID encoding means and documentary image data corresponding to said specific document, said

(3) output means (printing means for printing document with ID mark, ref. #37, fig. 2, col. 2, lines 31-37) for outputting documentary image with document ID mark generated by said pattern synthesizing means, while storing it in said storing means, and

(4) a dialogue type operating means (DocID software for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) capable of judging whether or not to add a documentary ID mark to the documentary image output from said output means.

Regarding claim 15, Lopresti further discloses a digital integrated apparatus capable of storing documentary image data corresponding to some specific document input from at least one kind of documentary image input means by attaching document ID identifying the documentary image data in at least one kind of storing means controlling attribute information containing that document ID with document management means, and outputting documentary image specified based on said document ID, by adding document ID mark corresponding to said document ID, from output means as required, comprising:

(1) a documentary image reading means (col. 4, lines 29-50) for reading ID mark printed on said documentary image with document ID mark;

(2) a document ID decoding means (decoding means, fig. 5) for decoding the read document ID mark into document ID, and;

(3) said document management means (control panel, fig. 3) for specifying, for the purpose of some specific processing, documentary image corresponding to either the document ID obtained from document ID decoding means (fig. 5) or the document ID input in character string directly from an input/output device, based on the selection a user makes with the input/output device between document ID mark input or character string input.



Regarding claim 16, Lopresti further discloses a digital integrated apparatus as defined in claim 15, wherein said specific processing is take-out of document by the output means (i.e. facsimile apparatus, fig. 4).

Regarding claim 17, Lopresti further discloses a digital integrated apparatus as defined in claim 16, comprising a document ID mark encoding means for generating document ID mark based on said document ID to the documentary image taken out as a result of said take-out of document, and a pattern synthesizing means for combining said generated document ID mark and the target documentary image and transferring it to the output means (figs. 4-5).

Regarding claim 18, Lopresti further discloses a digital integrated apparatus as defined in claim 17, wherein said document ID encoding means outputs document ID mark and position information including a form size layout position (layout parameters, col. 6, lines 50-67) to the pattern synthesizing means, and wherein said pattern synthesizing means determines a position of the document ID mark based on said position information.

Regarding claim 19, Lopresti further discloses a digital integrated apparatus as defined in claim 15, wherein said specific processing is copying or moving of target documentary image data from specific type of storing means to other specific type of storing means (via network, fig. 4).

Regarding claim 20, Lopresti further discloses a digital integrated apparatus as defined in claim 15, comprising said document management means for transmitting to at least said input/output device, upon receipt of document ID corresponding to some specific document, a plural number of attribute information mutually linked to said specific document, in the case where said document management means controls the link information indicating that specific documentary image and other documentary image are related to each other in contents, and said input/output device for displaying the attribute information obtained from said document management means to the user for selection so that the user may select the target documentary image (fig. 3, cols. 5-6).

Regarding claims 21-24, Lopresti further discloses a digital integrated apparatus as defined in claim 15, wherein said specific processing is combination for mutually combining a plural number of documentary image data by the document management means (i.e. archive server, fig. 2, cols. 5-8).

Regarding claim 25, Lopresti further discloses a digital integrated apparatus as defined in claim 15, comprising a facsimile receiving means as said documentary image input means, and a facsimile transmitting means as output means, said document ID decoding means decoding the document ID mark attached to the documentary image received from the facsimile, and the document management means outputting image data corresponding to specific document, based on the document ID obtained as a result of said decoding, to a facsimile in a distant place through said facsimile transmitting means (figs. 4-5).

Regarding claim 26, Lopresti further discloses a digital integrated apparatus as defined in claim 25, comprising said document ID encoding means for generating a second document ID mark in a readable size (fig. 2) by reading a first document ID attached to the documentary image received from the facsimile according to the user's instruction from the output/input device, and a pattern synthesizing means for combining the generated second document ID mark with the target documentary image and transferring them to the output means (fig. 4-5).

Regarding claim 27, Lopresti further discloses a digital integrated apparatus as defined in claim 26, comprising said document ID encoding means for generating document ID mark corresponding to the document ID including password (col. 8, lines 13-35) input according to the user's instruction from the input/output device.

Regarding claim 28, Lopresti further discloses a digital integrated apparatus as defined in claim 26, comprising an input/output device capable of setting the number of output copies (fig. 3) for all pages of documentary image with document ID mark corresponding to specific documentary image and/or documentary image.

Regarding claims 29-56 recite limitations that are similar and in the same scope of invention as to those in claims 1-28 above and combination thereof; therefore, claims 29-56 are rejected for the same rejection rationale/basis as described in claims 1-28.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

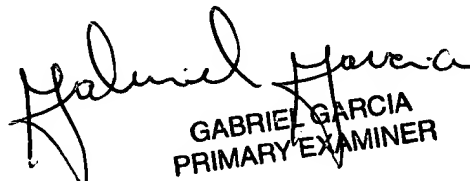
(1) U.S. 6035308 to Yano et al, discloses a printed document comprising a barcode (fig. 2) for encoding information linking to the digital representation of the original documents.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

  
GABRIEL GARCIA  
PRIMARY EXAMINER